

REMARKS/ARGUMENTS

Applicants respectfully submit that Claims 1, 4-22 and 25-41 are pending in this Application. Applicants request that the Examiner cancel Claims 2, 3, 23 and 24. In the Office Action mailed on March 9, 2005, the Examiner, *inter alia*:

- 1) rejected Claims 1-19 under 35 U.S.C. § 112, 1st paragraph as allegedly failing to comply with the enablement requirement;
- 2) rejected Claims 20-41 under 35 U.S.C. § 112, 2nd paragraph as allegedly being indefinite; and
- 3) rejected Claims 1, 6-14, 16, 20, 25, 27-30 and 32-39 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,705,561 to *Kozakiewicz et al.* (the “Kozakiewicz reference”).

Applicants respectfully address these items below.

Rejection under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner rejects Claims 1-19 under §112, first paragraph as allegedly failing to comply with the enablement requirement. The Examiner alleges, for example, that Claims 1-19 contains subject matter which was not described in the specification in such a manner as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner alleges that the specification is only enabling for a process wherein the reactive diluent is contacted with the other ingredients in a mixer.

Applicants respectfully disagree and submit that there is sufficient disclosure within the specification, as originally filed, to support the subject matter in Claims 1-19. For example, in the specification, Applicants disclose that a “reactive diluent may be added to the polymer composition in an amount sufficient to reduce an amount of solvent used, thus allowing for a greater percent yield of solvent material when the sealant is formed.” (Applicants’ Specification, p. 17, paragraph [0043]).

As another example, Applicants submit that the “[s]ealants of the present invention may be formed in any suitable reactor such as for example, a large scale reactor, or a small-scale reactor such as a four-neck glass reactor employing a stirring rod, temperature probe, addition funnel and a reflux drip-leg heating mantle to control temperature. Sealants may also be formed in a mixing unit containing a sweep blade employing a high-speed dispenser.” (Applicants’ Specification, p. 15, paragraph [0042]).

Accordingly, the specification supports processes wherein the reactive diluent is contacted with other ingredients in a mixer *and* in a variety of other suitable reactors. Applicants therefore respectfully request favorable reconsideration and withdrawal of the rejection to Claims 1 and 4-19. Please note that Applicants have requested Claims 2 and 3 be cancelled.

Rejection under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejects Claims 20-41 under §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter for which the Applicant regards as its invention. For example, the Examiner alleges that Claims 20-41 recite a sealant composition comprising a reactive diluent. The Examiner goes on to suggest that the process claims recite a process in which the reactive diluent is contacted with other ingredients under reaction conditions. Finally, the Examiner suggests that it is not understood how the reactive diluent would be present as a diluent after reaction.

Applicants have amended the claims to clarify and submit that amended Claim 20 overcomes the Examiner’s objection. Claims 21, 22 and 25-41 ultimately depend on Claim 20 and therefore also overcome the Examiner’s objection. Accordingly, Applicants respectfully request favorable reconsideration and withdrawal of the rejection to Claim 20-22 and 25-41. Please note that Applicants have requested Claims 23 and 24 be cancelled.

Rejection under 35 U.S.C. §102(b) as being anticipated by the Kozakiewicz reference:

In the Office Action, the Examiner rejects Claims 1, 6-14, 16, 20, 25, 27-30 and 32-39 under §102(b) as being anticipated by the Kozakiewicz reference. Applicants respectfully disagree. To be anticipated, a reference must teach each and every element of the claim *as set forth in the claim*. (See MPEP 2131).

Claim 1:

The Kozakiewicz reference fails to disclose, for example, a process for producing a sealant comprising the step of: contacting in a reactor under reaction conditions a reactive diluent, wherein the reactive diluent is an alkylene carbonate, as required by amended Claim 1. Claim 1 is thus allowable. Accordingly, Applicants therefore request favorable reconsideration and withdrawal of the rejection to Claim 1.

Claims 6-14 and 16:

With regards to Claims 6-14 and 16, Applicants respectfully traverse the Examiner's arguments and submit that Claims 6-14 and 16 are allowable under the same arguments that were presented above. Applicants therefore request favorable reconsideration and withdrawal of the rejection to Claims 6-14 and 16.

Claim 20:

The Kozakiewicz reference fails to disclose, for example, a sealant composition comprising: a polymer comprising at least one vinyl, acrylate or methacrylate monomer and at least one silane comonomer, at least one polymer capping agent, a catalyst, and a byproduct of a reactive diluent, wherein the reactive diluent is an alkylene carbonate, as required by amended Claim 20. Claim 20 is thus allowable. Accordingly, Applicants therefore request favorable reconsideration and withdrawal of the rejection to Claim 20.

Claims 25, 27-30 and 32-39:

With regards to Claims 25, 27-30 and 32-39, Applicants respectfully traverse the Examiner's arguments and submit that Claims 25, 27-30 and 32-39 are allowable under the same arguments that were presented above. Applicants therefore request favorable reconsideration and withdrawal of the rejection to Claims 25, 27-30 and 32-39.

CONCLUSION

In light of the remarks and arguments presented above, Applicants respectfully submit that the pending and amended claims in the Application are in condition for allowance. Favorable reconsideration and allowance of Claims 1, 4-22 and 25-41 is therefore respectfully requested.

Applicants hereby authorize the Commissioner to charge any fees, other than the issue fee, that may be required by this paper to Deposit Account 07-0153. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Date



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